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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Philip M. Ginsberg

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12/22/2008

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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3691

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/022,664	<b>Applicant(s)</b> GINSBERG, PHILIP M.	
	<b>Examiner</b> OLABODE AKINTOLA	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-8,38,39,41-44,74,75,80,82-87,92 and 94-140 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-8,38,39,41-44,74,75,80,82-87,92 and 94-140 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/2008 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-8, 74-75, 80, 82-85, 98-106 and 133-140 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is

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met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per Claims 2-8, 74-75, 80, 82-85, 98-106 and 133-140, Examiner asserts that Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 3, 5-8, 38-39, 41-44, 74-75, 80, 82-87, 92 and 94-140 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmelstein (US 6993511) (“Himmelstein”) in view of Wang (US 6604107) (“Wang”) and further in view of Whitworth (US 6622129) (“Whitworth”).

Re claims 2, 38, 105, 106, 114, 115, 116, 131, 132, 133, 140: Himmelstein teaches a method comprising: receiving an offer to enter into an agreement during a present time to purchase or sell an item at a designated future date of delivery of the item, the offer defining a first parameter comprising a description of the item (Figs. 9A and 9B; col. 24, lines 25-29); generating a futures contract for the item based on the offer (Fig. 8); storing the futures contract order in a database (Fig. 8, ele. 116); receiving a query comprising a second parameter, the second parameter comprising description of the item (col. 10, lines 13-23); determining that the first parameter of each of the plurality of futures contracts matches the second parameter of the query (col. 10, lines 13-23); transmitting the plurality of futures contracts in response to the query (Fig. 6); receiving a request to select a futures contract from the plurality of transmitted futures contracts (Fig. 6); and generating an agreement to exchange ownership of the item the designated future date in accordance with the selected futures contract (Fig. 6, ele. 633, 634; col. 16, lines 23-33).

Himmelstein does not explicitly teach that the item is a vehicle and the first and second parameters comprise at least one of: a year of the vehicle, a manufacturer of the vehicle and a model of the vehicle; and delivering the vehicle, in accordance with agreement, on the future

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date. However, Himmelstein teaches durable good/items including gold (Fig. 9B, col. 1, line 16 “items”).

Whitworth teaches futures exchange for vehicles of a given model and model year, and delivering the vehicle in accordance with an agreement on a future date (col. 5, lines 17-27 and lines 38-40; col. 11, lines 18-21 and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmelstein’s futures contract to include a vehicle futures contract because this will enhance the flexibility and the field of use of the process/system by being able to create futures contract for any type of goods or commodities (not only for gold or vehicles) and delivering the goods according to the terms of the contract.

Wang teaches creating a data structure for automobiles having attributes including (1) make, (2) model, (3) year and (4) color (col. 1, lines 19-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmelstein and Whitworth combination to include at least a descriptive parameter of a vehicle as taught by Wang for the obvious reason of classifying the vehicles according to type, model, year and color.

Re claims 3, 39, 136: Himmelstein teaches the at least one first parameter and the at least one second parameter comprise at least one of a category field, a item details field, a future contract period field, and a search query field (figs. 3, 5F, 6, 9A-9B).

Re claims 5, 41, 99, 108, 125: Himmelstein teaches the at least one first parameter and the at least one second parameter comprise at least one of: receiving a definition for the item, a price for the item, and specifications for the item (figs. 9A, 9B).

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Re claims 6, 42: Himmelstein teaches the at least one first parameter and the at least one second parameter comprise at least one of: a transfer of ownership date; and receiving an expiration date (figs. 9A, 9B).

Re claims 7, 43: Himmelstein teaches the at least one first parameter and the at least one second parameter comprise: a first date at which ownership of the item is available for transfer, a second date at which ownership of the item expires, and the value at the second date (figs. 6, 9A, 9B).

Re claims 8, 44, 100, 101, 109, 110, 126, 127: Himmelstein teaches the at least one first parameter and the at least one second parameter comprise: a date at which the selected futures contract expires (figs. 6, 9A, 9B, abstract).

Re claim 74, 86, 117: Himmelstein teaches receiving the at least one first parameter and the at least one second parameter through a trading interface, in which the trading interface comprises: at least one form element for a user to the at least one first parameter and the at least one second parameter; and at least one button selectable by the user in order to submit the at least one first parameter and the at least one second parameter (figs 5A-5F).

Re claims 75, 87, 118: Himmelstein teaches receiving an acceptance of the agreement (col. 1, lines 13-35)

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Re claims 80, 92, 119, 134: Himmelstein teaches one of purchasing and selling the item at the future date (figs 9A, 9B).

Re claims 82, 94, 120: Himmelstein teaches searching the database for at least one futures contract, in which the at least one contract comprises at least one first parameter that matches the at least one second parameter of the query (figs. 1, 4D).

Re claims 83, 95, 121: Himmelstein teaches listing at least one futures contract order, in which the at least one contract comprises at least one first parameter that matches the at least one second parameter of the query (fig. 4D).

Re claims 84, 96, 122, 138: Himmelstein teaches receiving a request for information associated with at least one of the plurality of transmitted futures contracts; and transmitting the information (col. 17, lines 36-45)

Re claims 85, 97, 123, 139: Himmelstein does not explicitly teach receiving a request to compare at least two of the plurality of transmitted futures contracts; and comparing the at least two of the plurality of transmitted futures contracts. Official notice is hereby taken that the concept of comparing two items is old and well. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmelstein to include this feature. One would have been motivated to do so in order to allow the parties review the contracts for quick decision.



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Re claims 98, 107, 124, 135: Himmelstein does not explicitly teach the vehicle comprises one of: of an automobile, a watercraft and an aircraft. However, Himmelstein teaches durable goods including gold (Fig. 9B). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Himmelstein's durable good to include an automobile, a watercraft and an aircraft. One would have been motivated to do so in order to increase the trading options of the users, thereby increasing the flexibility of the process/system.

Re claims 102, 111, 128, 137: Himmelstein teaches receiving a plurality of terms associated with executing the agreement; transmitting an acceptance of the plurality of terms; and transmitting an acceptance of the agreement (col. 5, lines 36-59).

Re claims 103, 112, 129: Himmelstein teaches the plurality of terms comprises at least one of: a period of the agreement, a method of payment, a method of delivery, an amount of liquidity damage resulting from a breach of the agreement, and a fee associated with the amount of liquidity damage (col. 18, lines 41-48).

Re claims 104, 113, 130: Himmelstein teaches receiving an acceptance of the plurality of terms; and receiving an acceptance of the agreement (col. 1, lines 30-35).

***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/  
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